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09/987,438	11/14/2001	John Wirth JR.	3584-6	6765

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NIXON & VANDERHYE P.C.
8th Floor
1100 North Glebe Road
Arlington, VA 22201

EXAMINER
JANVIER, JEAN D

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/987,438	WIRTH, JOHN
	Examiner	Art Unit
	Jean D Janvier	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 November 2003*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-52* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-52* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

The title of the invention is not descriptive so as to help one having ordinary skill in the art understand the nature of the subject matter. A new title is required that is clearly indicative of the invention to which the claims are directed. Further, the abstract of the disclosure cannot exceed 150 words (Ca 15 lines). See 37 CFR 1.72.

Status of the claims

Claims 1-52 are now pending in the Instant Application.

Claim Objections

Claim 1-52 are objected to because of the following informalities:

Throughout the claimed invention, "persons" should be replaced with --users, customers or recipients--.

Further, the claims, at the independent claims, should be reviewed or perhaps re-written to correct some improprieties or improve the claim language. For more information or assistance, the Applicant should contact the Examiner.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or
described as set forth in section 102 of this title, if the differences between the subject
matter sought to be patented and the prior art are such that the subject matter as a
whole would have been obvious at the time the invention was made to a person
having ordinary skill in the art to which said subject matter pertains. Patentability
shall not be negatived by the manner in which the invention was made.

Claims 1-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shane, US

Patent 5, 793, 972 in view of Bezos, US Patent 6, 029, 141.

As per claims 1, 25, 39, 2-5, 8, 10-11, 16-24, 26-28, 32-38, 40 and 46-52, Shane discloses

a system for providing an interactive response to direct mail programs comprises a recipient

database, a mail generator, and a web server computer (first device) operationally connected

through the Internet to remote computers (second devices) accessible by direct mail recipients **or**

screened users. The recipient database stores data records containing addressing information

such as the name, mail, fax or e-mail address, and a unique personal identification code or PIN

number for each direct mail recipient (recipient database stores mailing list parameters). **The**

mail generator retrieves recipient data from the database and generates a multiplicity of

direct mail pieces each displaying the name, address, and a uniform resource locator or

URL containing the personal identification code for a screened or targeted recipient. The

targeted or responding recipient accesses the web server (first device) or central computer by

entering the uniform resource locator or URL displayed on the received direct **mail piece or mailer (paper form),** mailed via the post office or e-mailed to the targeted recipient, into a local web browser outputted on his remote computer or second device (logging step). The web server computer retrieves recipient data from the recipient database correlated to the <u>personal</u> identification code or PIN contained in the uniform resource locator and uses this recipient data to create a unique interactive <u>web page</u>, where the recipient or respondent views personal messages or ads directed to his attention.

Here, recipient database 12 <u>stores</u> recipient data records 22 containing recipient <u>addressing</u> information, such as the recipient's name and <u>address</u> and a unique <u>personal</u> identification code for each intended direct <u>mail</u> recipient. Typically the recipient data (mailing list) contained in the recipient data records 22 is obtained (by purchase or lease or rental) from a <u>mailing list</u> broker and entered or stored into the recipient database 12. The recipient database 12 may also include demographic and tracking information for each recipient (col. 3: 64 to col.4: 5).

Further, <u>mail</u> generator 14, typically located in a lettershop, is electronically coupled to recipient database 12 so as to be capable of retrieving the recipient data for each intended or targeted (via a screening or filtering process) direct <u>mail</u> recipient or user. Preferably, <u>mail</u> generator 14 of fig. 1 comprises a computer system 24 including a printer 25 for printing direct <u>mail</u> pieces 26 displaying thereon the name, <u>address</u> and uniform resource locator (or URL related to a web site) containing a unique <u>personal</u> identification code, for each intended recipient. <u>Mail</u> generator 14 also typically <u>addresses</u> and prepares direct <u>mail</u> pieces or mailers 26 for <u>mailing</u> through a postal system 28, which delivers <u>mail</u> pieces 26 to a plurality of locations 29, typically the home or office of each targeted or screened recipient (col. 4: 6-19).

In short, Shane discloses in fig. 4, the steps (of the method 100) carried out by apparatus 10. An <u>advertiser</u> obtains one or more <u>mailing lists</u> from a list broker (by leasing or purchasing the mailing lists), wherein the mailing lists (raw data) are sent to a data house, along with any in-house lists and <u>suppression</u> lists that the <u>advertiser</u> has previously generated (Block 102). The data contained on the <u>mailing</u> and in-house lists are processed or filtered to <u>eliminate</u> duplicates and to prevent <u>mail</u> from being sent to certain individuals or <u>addresses on the suppression</u> lists, which the <u>advertiser</u> has previously determined would be inappropriate, to generate a recipient database 12 (screening the mailing lists to eliminate duplicate names or to prevent delivery to certain recipients' in a suppression list based at least on their addresses or locations, etc -Block 104). In a typical direct <u>mailing,</u> the direct <u>mail</u> pieces 26 would then be printed by merging a pre-prepared form letter with data from the <u>mailing lists,</u> and the direct <u>mail</u> pieces or mailers 26 would be prepared for <u>mailing</u> and deposited with the <u>post office</u> 28 (col. 5: 63 to col. 6: 11).

In a preferred embodiment, the system also generates a respondent database containing the recipient data record for each responding recipient. The system also preferably is capable of detecting unauthorized attempts to generate <u>personalized web pages</u> by detecting an invalid <u>personal</u> identification code which does not <u>match</u> any of the <u>personal</u> identification codes <u>stored</u> in the recipient database (col. 4: 33-49).

See abstract; figs. 1-4; col. 2: 22 to col. 3: 32.

Finally, Shane supports, in general, the steps of printing users' names and addresses on mail pieces or mailers, containing advertising or promotions, and mailing the mail pieces to the

users by a data house (processing mail pieces). The users may respond via phone calls or by

ordering products featured in the mail pieces. Shane also discloses that the mailing lists can be

rented or leased from a third party or broker (col. 1: 30-67).

As per claims 1, 25 and 39, although, Shane supports, in general, the steps of printing

users' names and addresses on mail pieces or mailers, containing advertising or promotions, and

mailing the mail pieces to the users by a data house (processing mail pieces), wherein the users

may respond via phone calls or by **ordering products** featured in the mail pieces, however,

Shane does not expressly teach accessing by a user or customer or mail recipient a first device or

web site associated with a mailer to place an order.

However, Bezos discloses an Internet-based referral service that enables a business or

other entities or advertiser's associates to refer via a web site (web sites) customers, using a

referral link displayed at the advertiser's associate web site 100, to a Merchant's or advertiser's

web site 106 where they can receive more information regarding an advertised product/service or

even purchase one or more products including the advertised product/service. The business or the

advertiser's associate first registers with the referral service (providing an enrollment system) by

setting up a referral link in his existing web site 100 which, upon actuation by a visiting customer

viewing a product information, transports the customer to the Merchant web site 106 to receive

more product information or purchase the associated product or other products. Subsequent to

enrolling the advertiser's associate, an account or an ID or an identifier is created in real-time for

the advertiser's associate or business (assigning an advertiser associate account identifier to

uniquely identify the advertiser's associate) and this account is stored in a database related to the

Merchant's or advertiser's web site 106 where it can be used to credit the advertiser's associate

for each successful referral or when the customer buys the associated product featured in the

product information displayed at the associate's web site. In addition, when the customer selects

the referral link, the customer's computer 108 transmits unique IDs or identifiers of the selected

product and of the advertiser's associate to the Merchant or advertiser web site 106, which

allows the Merchant or advertiser to identify the advertised product and the referring advertiser's

associate in an effort to properly compensate the referring advertiser's associate (using the

assigned advertiser associate's account identifier) (See abstract; figs. 1-4; col. 7: 6-60). Further,

Bezos explicitly shows in fig. 4 a URL 400 format used by the associate to create the referral

link to the Merchant's or advertiser's web site 106, wherein the URL 400 comprises the

Merchant's or advertiser's web server information (web site) 402, the unique product ID 404, the

unique store ID or advertiser's associate web site identifier 406 for uniquely identifying the

advertiser's associate web site 100 and the advertiser's associate commission scheme ID 408 and

wherein the advertiser's associate commission ID 408 is used to optionally specify a commission

percentage or a method for calculating the referral commission (col. 10: 39-67; col. 11: 1-26; figs

3-4).

In a preferred embodiment, the referral service system provides a software system and

method for enabling an Internet merchant or advertiser to efficiently market and sell goods in

cooperation with Web sites or other network sites of respective business partners, referred to

herein as "associates." Through the merchant's site, an entity or individual or business can enroll

(via an automated registration process) as an associate, and can then disseminate to visiting customers catalogs (Web documents, PUSH documents, e-mail newsletters, etc.) that include the associate's reviews and/or recommendations on specific products sold by the merchant (col. 1: 50-61). In other words, the product information or promotion or offer mailer (catalog documents), having printed therein the merchant's URL for facilitating the purchase of a product, can be distributed to targeted or visiting users via e-mail or delivery means (col. 1: 50-61). For example, the catalog documents 120 of fig. 1 served by the associate's site 100 include special hyperlinks (to Web pages of the merchant Web site 106) for allowing consumers to select products for prospective purchase. Typically, one such hyperlink is provided for each product displayed on the associate's Web site 100. Alternatively, a hyperlink may be provided for a group of products. When a customer selects (e.g., clicks on) the hyperlink associated with a particular product, the customer is automatically connected to the merchant Web site 106 via the associate's web site, and presented with various options (included within Web pages 136 served from the merchant Web site 106) for allowing the customer to purchase the selected product from the merchant. The hyperlink thus serves as a referral mechanism for referring the customer to the merchant Web site 106 (col.7: 6-20).

Although the embodiment described herein uses Web technology to disseminate the catalog documents, any of a variety of document types and electronic dissemination technologies can be used. For example, the associate's catalog documents may be in the form of hyper-textual e-mail messages that are disseminated by a list server, or PUSH documents disseminated by a PUSH server. As interactive television, video-on-demand, and Web TV technologies continue to evolve, it is contemplated that the "catalog documents" will include video advertisements that are

displayed to the customer on a television screen. Further, although hyper-textual catalog

documents are preferably used, it is possible for an associate to use non-hyper-textual catalogs

(including paper-based product catalogs including the associate's web site address) that simply

instruct the customer to manually enter the appropriate URL (including the referral information

or web site address of the merchant) into a local browser program (col. 8: 32-48).

Finally, providing or presenting to a user an advertising or promotional message, having

printed thereon a URL or web site address where a product featured in the advertising message

or other products can be purchased is well documented and well taught in the art.

Therefore, an ordinary skilled artisan would have been motivated at the time of the

invention to incorporate the Bezos' teachings into the system of Shane so as to enroll or register

businesses or entities or individuals to become associates of at least one advertiser and to directly

market products sold at the at least one advertiser's or merchant 's web site by distributing

related product information or product offer or mailer or catalog documents, having printed

therein the merchant's URL address or referral link, to targeted customers via an associate's web

site (e-mail or regular mail delivery) when a customer or user or recipient visits the associate's

web site and clicks on a referral link associated with a product offer and displayed thereon (or

manually enters the merchant's URL into a local browser) to be transported to the at least one

advertiser's or merchant's web site where the customer can receive more product information on

a product advertised or featured in the displayed or mailed product offer or to simply purchase

the advertised product or other products and wherein if the user or customer purchases the

advertised product, then the referral service system extracts from the referral link the product ID

and the associate's web site identifier (store ID) to uniquely identify and compensate the

referring web site or the associate for a successful referral, thereby enabling the businesses or

entities or individuals or associates to participate in the advertising referral service or system and

become registered associates of the at least one advertiser and market products sold at the at least

one advertiser's web site by disseminating related product information to targeted users or

customers in exchange for a commission when a customer purchases at the advertiser's or

merchant's web site a product advertised at the associate's web site and upon conclusively

matching the associate's web site identifier (store ID) with a store ID extracted or read from the

referral link, which was actuated by the referring customer, while providing more time to the

advertiser to develop more business strategies since the distribution of the product offer is now

handled by a plurality of independent associates working on behalf of the advertiser with

minimal supervision or oversight since the system is performance based.

As per claims 6-7, 9, 29, and 41, although Shane discloses a recipient database (of the

first device) storing recipients' demographic information, however, the combination of Shane

and Bezos does not explicitly mention filtering or screening a mailing list, containing recipients'

names, based on the users' or recipients' income, age (or demographic information) or purchase

history.

However, providing targeted information to a user or filtering or screening content to be

displayed to a user based on the user's demographic data or purchase history data is well

documented or taught in the art (no further disclosure is necessary here). ("Official Notice")

Therefore, an ordinary skilled artisan, implementing the systems of Shane and Bezos,

would have been motivated at the time of the invention to incorporate the above public

disclosure or "Official Notice" into the system of Shane and Bezos so as to screen or filter the

incoming mailing lists, containing users' names, in accordance with the users' or recipients'

demographic profile (age, income, education, location, etc.) or purchase history profile matching

the advertiser's target market and to store or record the result of the filtering process or the

screened users' names in the recipient database for later retrieval and usage, thereby rendering

the system more effective by processing or filtering **the data (users' names) contained on the**

mailing and the advertiser's in-house lists to <u>eliminate</u> duplicates and to prevent <u>mail</u> or

product information from being sent to certain individuals on the suppression lists (and

incoming mailing lists), which the <u>advertiser</u> has previously determined would be

inappropriate to receive a particular mailer or product information based on, for example,

the users' location, income, age, gender, etc. (demographic parameters) or purchase history

profile, before generating the recipient database 12 storing the screened or filtered names,

while presenting targeted product offer to the filtered users' names, specifically directed to those

users' attention.

As per claims 12-15, 30-31 and 42-45, although Shane teaches sending the information to

a targeted user in paper form, the combination of Shane and Bezos does not explicitly mention

providing the information to the user on a post card, chosen or made from high visibility or

bright color paper stock that contrasts with the user's name and information printed thereon.

However, it is common practice to mail product information to a user via a flyer or other

conventional form of mailer, chosen from white or color paper of high quality. Furthermore,

printing the information on a post card, made from high visibility or bright color paper stock, as

opposed to a flyer, made from a white or color premium paper is a matter of desires.

"Official Notice"

Therefore, an ordinary skilled artisan, implementing the systems of Shane and Bezos,

would have been motivated at the time of the invention to incorporate the above public

disclosure or "Official Notice" into the systems of Shane and Bezos so as to print the user's

name, address, PIN and URL (CGI string) on a medium such as a flyer or post card made of high

quality premium color paper, wherein the post card or flyer is subsequently mailed to the user,

thereby giving a professional look to the mailing piece or mailer, containing the information,

while rendering it more attractive to the user, who is induced to read the enclosed information or

content printed in the flyer or post card and uniquely directed to the user's interest or attention.

Conclusion

Although the following references were not used in the Office Action, they were highly

considered by the Examiner. Applicants are further directed to consult these references.

US Patent 6, 567, 786B1 to Bibelnieks discloses a method, and system for increasing the

efficiency of customer contact strategies is disclosed. Customers are analyzed based upon

historical criteria; a promotional plan (a group of promotion events implemented or to be

implemented over a particular time period) is analyzed to determine the effect of each promotion

event on the other promotion events in the promotional plan; and, based on this analysis, the

optimal promotion stream (a specific subset of the promotional plan to be sent to customers or a

group of similar customers) is determined so as to maximize the ROI of the promotional plan as

a whole.

US Patent 6, 076, 101 to Kamakura discloses an electronic mail processing system for

distributing an e-mail message from a sender to recipients, which encourages the recipients to

open, read, and reply to the e-mail message sent from the sender. An original e-mail message

sent from a sender via a sender terminal is stored in an outgoing message storage unit. An

outgoing mail information registration unit stores a list of recipients to whom the e-mail message

should be delivered, as well as storing information on bonus points. A message sending unit

encloses bonus point information in the e-mail message and distributes it to the recipients

included on the list. Upon receipt of a reply message from one of the recipients, a reception

process unit gives a predetermined number of bonus points to the recipient. Each recipient's

bonus points are accumulated in a recipient information storage unit, and he/she can redeem

his/her bonus points for gifts depending on the accumulated points. This structural arrangement

encourages the recipients to open the sender's message and write reply messages thereto in

expectation of the redeemable bonus points, thus allowing the original message sender to collect

more reply messages from the recipients than normally expected.

Any inquiry concerning this communication from the Examiner should be directed to

Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally

be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner

by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached

at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113.

Further, the following fax numbers can be used, if need be, by the Applicant(s):
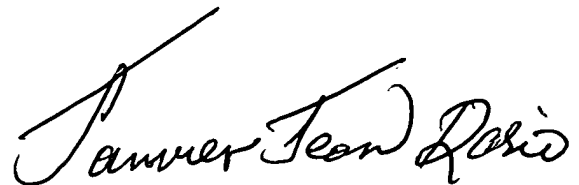
After Final-   703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

09/18/04

JDJ

Jean D. Janvier

Patent Examiner

Art Unit 3622